

REMARKS

Claims 3-7, 10, 13, 14 and 16-18, 20 and 23-27 are now in the application. Claims 3-5, 10, 13-14 and 20 and 23-25 are directed to the elected invention. Claims 6, 7 and 16-18 are drawn to non-elected invention and may be canceled by the Examiner upon the allowance of the claims directed to the elected invention. Basis for claim 24 can be found for example at page 5, line 9 and page 12, lines 15-25 of the specification. Basis for claim 25 can be found for example at page 3, lines 4 and 5 of the specification. Basis for claim 26 can be found for example at page 9, lines 12-17 of the specification. Basis for claim 27 can be found for example at page 15, lines 20-24 of the specification. Newly presented claims 24 -27 do not introduce any new matter.

Claim 23 was rejected under 35 U.S.C. 102(a) as being anticipated by JP 2002-275642 (JP'642). Claims 1-5, 10, 13-14 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over JP'642. JP 2002-275642 does not anticipate and does not render obvious the present claims. As a preliminary matter, it should be noted that claims 1 and 2 have been cancelled and therefore are not subject to these rejections.

JP 2002-275642 suggests a ground treatment agent containing a complex compound consisting of titanium hydroxide and hydrogen peroxide as main ingredients. The complex compound is contacted with a metal surface and dried by heating which causes the agent to form titanium oxide microparticles and the agent performs film-forming (see paragraph [0033] et seq.). From this viewpoint, the ground treatment agent suggested in JP 2002-275642 should be said to be a so-called application-type of surface treatment agent, and should be considered to be different from the chemical conversion treatment agent of the present application. The claim recitation "chemical conversion treatment agent" would exclude a ground treatment agent such as that suggested in JP 2002-275642.

JP 2002-275642 fails to anticipate the present invention. In particular, anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics*,

Inc. v. Safety Travel Chairs, Inc., 1 USPQ2d 1081 (Fed. Cir. 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

Each and every claim recitation must be considered. See *Pac-Tec, Inc. v. Amerace Corp.* 14 USPQ2d 1871 (Fed. Cir. 1990), cert. denied 502 US 808 (1991). The claimed recitation, “chemical conversion treatment agent” cannot be disregarded in interpreting the claims. The recitation is necessary to give life and meaning to the claims. The term “chemical conversion treatment agent” is a structural limitation on the scope of the claims. The Examiner’s attention is kindly directed to *Union Oil Co. of California v. Atlantic Richfield Co.* 54 USPQ2d 1227 (Fed. Cir. 2000); *Rowe v. Dror*, 42 USPQ2d 1550 (Fed. Cir. 1997) and *Corning Glass Works v. Sumitomo Electric USA* 9 USPQ2d 1962 (Fed Cir 1989). In *Corning*, the Federal Circuit held that the term “optical waveguide” in the claim preamble was a limitation and that the claim did not cover all types of optical fibers. Also, the Examiner’s attention is kindly directed to *L.P Varco v. Pason Systems USA Corp.*, 436 F.3d 1368, 1373, 77USPQ2d 1948, 1952 (Fed. Cir. 2006); *On Demand Machine Corp. v. Ingram Industries, Inc.*, 442 F.3d 1331, 1343, 78 USPQ2d 1428, 1437 (Fed. Cir.2006), *MBO Laboratories, Inc. v. Becton Dickinson & Co.* 474 F.3d. 1323, 81 USPQ2d 1661 (Fed. Cir. 2007) and *Bass Pro Trademarks, LLC. V. Cabela's, Inc.* 485 F.3d 1364, 82 USPQ 2d 1364 (Fed. Cir. 2007).

In addition, please see *Phillips v. AWH Corp.*, 415 F. 3d 1303, 75 USPQ 2d 1321 (Fed. Cir, 2005) for a discussion of claim construction and the role of the specification in ascertaining claim scope.

Concerning the polyallylamine, JP 2002-275642 seems to suggest allylamine as a monomer used for the purpose of comprising acrylic resin. However, there is no disclosure to the effect of using polyallylamine in the compositions suggested in JP 2002-275642.

In other words, polyallylamine is not disclosed in JP 2002-275642, but only acrylic resin using an allylamine unit as a monomer is suggested.

On the other hand, in paragraph [0065] of JP 2002-275642, while suggesting that “as an acrylic resin, for example, a monomeric homopolymer and a copolymer having such a hydrophilic group as a carboxyl group, an amino group, or a hydroxyl group ... and such can be

given,” in paragraph [0067], it is disclosed that “as a nitrogenous monomer, ...allylamine...,” so standardization of the terminology is not being achieved. For this reason, it is unclear that allylamine is here strictly a monomer for being included in the acrylic resin.

As noted above, polyallylamine is not used in JP 2002-275642, but only in an acrylic resin using allylamine as one monomer therein. In the invention in the present application, the purpose of polyallylamine being used is, that an effect of an amino group of polyallylamine is exhibited by polyallylamine incorporated into a chemical conversion coating film. However, in the invention suggested in JP 2002-275642, if a resin with a fewer number of amino groups compared to polyallylamine is used, as a matter of course, it can be considered that the adhesiveness would decrease.

The specification of JP 2002-275642 contains the following descriptions:

- a) allylamine is a nitrogen-containing monomer.
- b) the nitrogen-containing monomer has a hydrophilic group such as an amino group (paragraph 0065),
- c) the amino group is a group that is able to make soluble and disperse the polymer on its own (paragraph 0060, third sentence),
- d) the group that is able to make soluble and disperse the polymer is used to make an organic high molecular weight compound soluble, dispersed and emulsified in water (paragraph 0060, second sentence).

Therefore, polyallylamine is only suggested in JP 2002-275642 as a compound to make the organic high molecular weight compound soluble, dispersed and emulsified in water, in the method for obtaining the substrate treatment agent which is used to obtain a coating film by coating a steel plate and drying. On the other hand, in the present invention, polyallylamine is incorporated into the chemical conversion coating film, and makes the chemical conversion coating film highly adhesive to an upper layer, even if the

chemical conversion treated substrate is rinsed without prior drying. Therefore, polyallylamine in the present invention is a compound that is incorporated into the chemical conversion coating film and interacts with the upper layer via amino groups.

As stated above, the polyallylamine suggested in JP 2002-275642 that of the present invention are completely different in their effects. Therefore the present invention is not suggested by JP 2002-275642 and is not obvious there over.

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

The Office is authorized to charge any necessary fees due with this response to Deposit Account No. 22-0185 under Order No. 21581-00313-US from which the undersigned is authorized to draw.

Respectfully submitted,

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